UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/593,362	09/18/2006	Stefan Verseck	009848-0356699	1298	
	7590 03/31/200 VINTHROP SHAW PI		.P EXAMINER		
	TENTION: DOCKETING DEPARTMENT			JOIKE, MICHELE K	
McLean, VA 22	A DT LINIT DADED		PAPER NUMBER		
			1636		
			MAIL DATE	DELIVERY MODE	
			03/31/2009	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Applica	tion No.	Applicant(s)				
Office Action Summary		362	VERSECK ET AL.				
		er	Art Unit				
	MICHE	LE K. JOIKE	1636				
The MAILING DATE of this commu Period for Reply	nication appears on t	he cover sheet with the c	correspondence ad	ldress			
A SHORTENED STATUTORY PERIOD WHICHEVER IS LONGER, FROM THE - Extensions of time may be available under the provisio after SIX (6) MONTHS from the mailing date of this cor - If NO period for reply is specified above, the maximum - Failure to reply within the set or extended period for reply any reply received by the Office later than three month earmed patent term adjustment. See 37 CFR 1.704(b).	MAILING DATE OF one of 37 CFR 1.136(a). In no nonunication. statutory period will apply anoly will, by statute, cause the a	THIS COMMUNICATION event, however, may a reply be tir will expire SIX (6) MONTHS from pplication to become ABANDONE	N. nely filed the mailing date of this o D (35 U.S.C. § 133).				
Status							
1) Responsive to communication(s) f	led on 18 Sentembe	r 2006					
2a) This action is FINAL .	2b) This action is						
/	<i>'</i> —		secontion as to the	morite ie			
) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.						
closed in accordance with the prac	aice under Ex parte (zuayle, 1955 C.D. 11, 4.	03 O.G. 213.				
Disposition of Claims							
4)⊠ Claim(s) <u>1-11</u> is/are pending in the	application.						
	4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.	,						
6) Claim(s) is/are rejected.							
7) Claim(s) is/are objected to.							
8) Claim(s) 1-11 are subject to restrict	tion and/or election r	oquiromont					
OM Claim(s) <u>1-11</u> are subject to restrict	tion and/or election i	equirement.					
Application Papers							
9)☐ The specification is objected to by	he Examiner.						
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.							
Applicant may not request that any ob	•						
Replacement drawing sheet(s) including		•	• •	ER 1 121(d)			
11) The oath or declaration is objected	-	,		• •			
Tr) The battroi declaration is objected	to by the Examiner.	Note the attached Office	Action of lonner	10-132.			
Priority under 35 U.S.C. § 119							
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No. 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). 							
* See the attached detailed Office act Attachment(s) 1) Notice of References Cited (PTO-892)		4) Interview Summary	(PTO-413)				
Notice of Draftsperson's Patent Drawing Review Information Disclosure Statement(s) (PTO/SB/08 Paper No(s)/Mail Date		Paper No(s)/Mail Date 5) Notice of Informal F					

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8, 10, drawn to an expression system for expressing nucleic acid sequences encoding different subunits of a nitrile hydratase.

Group II, claim(s) 9, drawn to a method for preparing nitrile hydratases.

Group III, claim(s) 11, drawn to a method for preparing (amino) carboxylic acids or (amino) carboxamides.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature is an expression system for expressing nucleic acid sequences encoding different subunits of a nitrile hydratase. This element cannot be a special technical feature under PCT Rule 13.2 because the element is shown in the prior art.

The claims lack unity of invention because Applicants' invention is not novel. Nojiri et al (IDS reference, see Fig. 1, for example) teaches a plasmid containing the NHase operon (nitrile hydratase), which includes nucleic acid sequences encoding the α and β subunits. Therefore, claim 1 is anticipated by Nojiri et al.

Art Unit: 1636

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims.

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result

Application/Control Number: 10/593,362 Page 4

Art Unit: 1636

in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELE K. JOIKE whose telephone number is (571)272-5915. The examiner can normally be reached on M-F, 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571)272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michele K Joike/ Examiner, Art Unit 1636 Michele K Joike Examiner Art Unit 1636